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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92052897
Party	Defendant Galderma Laboratories, Inc.
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II. Argument

The Board should resume this Cancellation as it has been fully litigated and is ready for decision, whereas the civil action is in its infancy with Answers still to be filed, and since the Board's power to suspend an action pending the outcome of a civil action is discretionary. 37 C.F.R. § 2.117(a). *See also* TBMP § 510.02(a) ("Suspension of a Board proceeding pending the final determination of another proceeding is solely within the discretion of the Board[.]"). The Board has recognized that the discretionary nature of its power to suspend means that "suspension is not the necessary result in all cases." *Boyds Collection Ltd. v. Herrington and Co.*, 65 U.S.P.Q.2d 2017, 2018 (TTAB 2003). The Board has refused to suspend actions, even when moved to do so by one of the parties, where testimony and briefing periods had concluded and the Board proceeding was ready for a decision. *See, e.g., Id.* at 2020-21; *E.I. du Pont de Nemours and Co. v. G.C. Murphy Co.*, 199 U.S.P.Q. 807, 808 n.3 (TTAB 1978); *Ortho Pharmaceutical Corp. v. Hudson Pharmaceutical Corp.*, 178 U.S.P.Q. 429, 430 (TTAB 1973).

Suspension pending the outcome of Petitioner's civil action is neither necessary nor in the service of judicial economy. The Board has developed a policy of continuing an action notwithstanding a request for suspension when it has been asked to issue a potentially dispositive ruling before a Request for Suspension is received. *See* TBMP § 510.02(a). The purpose of this policy is to "prevent a party . . . from escaping [a potentially dispositive] motion by filing a civil action and then moving to suspend before the Board has decided the . . . motion." This policy is served whether a potentially dispositive motion is pending or, as is the case here, the proceeding is ready for final decision. *See* TBMP § 510.02(a); *see also Boyds v. Herrington*, 65 U.S.P.Q.2d at 2018 (TTAB 2003).

Here, the parties have spent more than four years aggressively litigating this matter before the Board, engaging in motion practice, conducting extensive discovery, taking testimonial depositions, and fully briefing the case. All testimony and trial periods have closed, and neither party requested that these proceedings be suspended. All that remains to this action are an oral hearing and the Board's final decision. Continuing the suspension in the instant action will only "delay the outcome of this proceeding when there would be little or nothing to resume upon conclusion of [P]etitioner's civil suit." *Id.* at 2019.

The Board should not allow such delay here, where trial has already concluded and the civil action is just beginning. These circumstances warrant an exercise of the Board's discretion to remove the suspension and continue the proceedings.

For the foregoing reasons, Registrant moves the Board to reverse its suspension order and resume these proceedings.

Respectfully submitted,



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